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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/017,194 12/12/2001 Eldad Taub 72524 6362

22242 7590 08/29/2003

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 08/29/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

1

Office Action Summary

Application No.

10/017,194

Applicant(s)

TAUB, ELDAD

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9,13,17,21,25 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-8,10-12,14-16,18-20,22-24,26-28 and 30-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Declaration and information Disclosure statement filed in Papers No. 3 and 5, April 15, 2002 and July 12, 2002, respectively, have been received. Currently, claims 1-43 are pending in the application.

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention, i.e., method steps of the to play the game; the virtual three-dimensional dental images; and virtual rules, tools, and components. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Note that, the applicant may use the illustrations from the incorporated references, however, no new matter may be added.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Virtual Dental Game.

Claims 1-29, 41, and 43 are objected to because of the following informalities: In claims 1, 41, and 43, the word "comprising" should follow the preamble.

Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 34, 39, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 34, the recited limitation "wherein said virtual three-dimensional dental image comprises substantially all teeth of at least one jaw" is repeating.

In claim 39, the recited phrase "said task" lacks antecedent basis.

In claim 43, the recited term "data carrier" is vague and indefinite since it is unclear whether the "data carrier" is a storage medium or a communication network.

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 41 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The program of claim 41 and data carrier of claim 43 are non-statutory subject matter. Note that, the claims may be amended to be statutory by inserting language stating that the computer program is encoded on a computer-readable medium; and the data carrier should be amended to be computer-readable medium.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8, 10-12, 14-16, 18-20, 22-24, 26-28, and 30-43 rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al. (6,227,850) in view of Fabricant (4,231,181).

Chishti et al. teaches a teeth viewing system, method, or a program having instructions embedded in a storage medium, in which a user, through a user interface, performs one or more tasks within a virtual environment, the system comprising: a virtual environment having a virtual three-dimensional dental image of at least one tooth of the user (Fig. 5); and said one or more tasks comprise improving a certain virtual condition associated with said at least one tooth; said virtual image comprises a plurality of teeth of at least a continuous section of teeth, substantially all teeth of at least one jaw, substantially all teeth of both the upper and lower jaws; the user can manipulate the mutual orientation of the two jaws; said condition is an inappropriate relative position or orientation of at least one tooth or of a jaw; and said one or more tasks comprise re-orientation of one or more teeth (Figs. 7-17); said one or more tasks are being performed by applying virtual rules, tools or components, corresponding to manner of dental, personal or orthodontic treatment of teeth or jaws; said condition a disorder in or lack of structural integrity of one or more teeth, and said one or more tasks comprise improving or fixing said disorder or lack of structural integrity; virtual rules comprise rules of movements of teeth or jaws corresponding to such in a real-life orthodontic

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treatment; extracting data from a storage medium, the data being representative of a virtual environment comprising a virtual three-dimensional dental image of at least one tooth of the user, and displaying said virtual environment; and performing, in response to a user command, one or more tasks within a virtual environment to obtain a modified environment and displaying same; storing data representative of said modified environment in a storage medium; repeating said performing step a plurality of times; manipulating, in response to a user command, the relative position or orientation of at least one tooth or of a jaw. See 1:50-20:65 and Figures 1-20. Chishti et al. does not explicitly teach the limitations of the system, method, or program embedded in a storage medium is for a computer game; virtual tools or components comprise virtual personal mouth hygiene tools (claims 18-20, 40); virtual tools or components are virtual orthodontic components corresponding to real-life orthodontic components (claims 22-24, 40); virtual rules permitting elimination of virtual infectious agents from the virtual teeth (claims 26-28).

Fabricant, however, teaches a dental toy comprising simulated tools or components comprise simulated personal mouth hygiene tools (Fig. 1); simulated tools or components are simulated orthodontic components corresponding to real-life orthodontic components; simulated rules permitting elimination of simulated infectious agents from the simulated teeth (3:24-27). See also, columns 1-4 and Figures 1-7.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Chishti et al.'s with a simulated dental toy of Fabricant to come up with a virtual dental game, especially with personalized feature, in

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order to attract more people other than regular game players, thus bring forth more profits from the game.


10. Claims 9, 13, 17, 21, 25, and 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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Teresa Walberg
Supervisory Patent Examiner
Group 3700